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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,681	11/05/2003	Deborah Ann Rathjen	273402602309	1120
25226	7590	02/03/2006	EXAMINER	
MORRISON & FOERSTER LLP			Ouspenski, ILIA I	
755 PAGE MILL RD			ART UNIT	
PALO ALTO, CA 94304-1018			PAPER NUMBER	

1644

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/702,681

Applicant(s)

RATHJEN ET AL.

Examiner

ILIA OUSPENSKI

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 9-54 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

1. Applicant's Preliminary Amendment, filed 12/12/2005, is acknowledged.

Claim 1 – 8 has been canceled.

Claims 9 – 54 have been added.

*Claims 9 – 54 are pending.*

2. For restriction purposes the following is noted:

The instant claims contain recitations of multiple distinct antibodies. These antibodies are patentably distinct because their structures, physicochemical properties and/or mode of action are different, and they do not share a common structure that is disclosed to be essential for common utility. Therefore, the restriction has been set forth for each as separate groups, irrespective of the format of the claims.

Applicant is invited to clarify the relationship between Mab number (as e.g. in claim 14) and binding specificity.

### ***Restriction Requirement***

3. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

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I. Claims 9 – 54, drawn to an isolated antibody Mab1 or fragment thereof, and to compositions comprising said antibody or fragment, classified in Class 530, subclass 387.1, and Class 424, subclass 130.1.

II. Claims 9 – 54, drawn to an isolated antibody Mab21 or fragment thereof, and to compositions comprising said antibody or fragment, classified in Class 530, subclass 387.1, and Class 424, subclass 130.1.

III. Claims 9 – 146, drawn to an isolated antibody Mab32 or fragment thereof, and to compositions comprising said antibody or fragment, classified in Class 530, subclass 387.1, and Class 424, subclass 130.1.

IV. Claims 9 – 146, drawn to an isolated antibody Mab42 or fragment thereof, and to compositions comprising said antibody or fragment, classified in Class 530, subclass 387.1, and Class 424, subclass 130.1.

V. Claims 9 – 146, drawn to an isolated antibody Mab47 or fragment thereof, and to compositions comprising said antibody or fragment, classified in Class 530, subclass 387.1, and Class 424, subclass 130.1.

VI. Claims 9 – 146, drawn to an isolated antibody Mab53 or fragment thereof, and to compositions comprising said antibody or fragment, classified in Class 530, subclass 387.1, and Class 424, subclass 130.1.

VII. Claims 9 – 146, drawn to an isolated antibody Mab54 or fragment thereof, and to compositions comprising said antibody or fragment, classified in Class 530, subclass 387.1, and Class 424, subclass 130.1.

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4. Groups I – VII are different products. The products are patentably distinct because their structures, physicochemical properties and/or mode of action are different, and they do not share a common structure that is disclosed to be essential for common utility. Furthermore, they require non-coextensive searches in the scientific literature. Therefore, each product is patentably distinct, and searching of these Inventions would impose an undue burden.

5. These inventions are distinct for the reasons given above. In addition, they have acquired a separate status in the art as shown by different classification and/or recognized divergent subject matter. Further, even though in some cases the classification is shared, a different field of search would be required based upon the structurally distinct products recited and the various methods of use comprising distinct method steps. Moreover, a prior art search also requires a literature search. It is an undue burden for the examiner to search more than one invention. Therefore restriction for examination purposes as indicated is proper.

6. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ILIA OUSPENSKI whose telephone number is 571-272-2920. The examiner can normally be reached on Monday-Friday 9 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571-272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ILIA OUSPENSKI  
Patent Examiner  
Art Unit 1644

PHILLIP GAMBEL  
PHILLIP GAMBEL, PH.D. J.D.  
PRIMARY EXAMINER  
TCH CENTRAL 1600  
1/30/2006

January 27, 2006